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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/048,027	01/28/2002	Toru Karasawa	111796	1264
7590	12/05/2005		EXAMINER	
Oliff & Berridge PO Box 19928 Alexandria, VA 22320			ZHOU, TING	
			ART UNIT	PAPER NUMBER
			2173	

DATE MAILED: 12/05/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	Application No.	Applicant(s)	
	10/048,027	KARASAWA ET AL.	
	Examiner	Art Unit	
	Ting Zhou	2173	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on 29 September 2005.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 1-4, 6 and 8-37 is/are pending in the application.
- 4a) Of the above claim(s) 11-19 and 22-37 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-4, 6, 8-10, 20 and 21 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☒ None of:
- ☒ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

### DETAILED ACTION

1. The Request for Continued Examination (RCE) filed on 29 September 2005 under 37 CFR 1.53(d) based on parent Application No. 10/048,027 is acceptable and a RCE has been established. An action on the RCE follows.
2. The amendments filed on 29 September 2005, submitted with the filing of the RCE have been received and entered. The applicant has cancelled claim 7. Claims 1-4, 6, 8-10 and 20-21 are examined below.

### *Claim Rejections - 35 USC § 103*

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 1-4, 6, 8, 10 and 20-21 are rejected under 35 U.S.C. 103(a) as being unpatentable over Tatsuji JP 8-153104, and Jackson U.S. Patent 5,960,444.

Referring to claims 1, 2 and 3, Tatsuji teaches a scenario creating device, method and computer-readable storage medium comprising an input section including a pointing device (input part 11 comprising input devices such as a keyboard and mouse) (Tatsuji: paragraphs 0021-0022 and Figure 1), a display section (output monitor) (Tatsuji: paragraphs 0021-0022 and Figure 1), and a scenario creating section for creating the scenario file in accordance with operation of the input section (the editor creates the

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scenario, or link order of the cards of a presentation for display) (Tatsuji: paragraphs 0025-0032); and wherein the scenario creating section provides a display of an execution icon on the display section for causing the scenario creating section to execute a process (displaying edit icon 102 in Figure 6) for carrying out a list display function) (Tatsuji: paragraphs 0049-0051), a file icon for a source file (as shown in Figure 8, a plurality of cards, or icons for the files of the input document are displayed) (Tatsuji: paragraphs 0051-0053), and in response to operation of the pointing device, the scenario creating section creates the scenario file of the predetermined format on the basis of the image information (in response to an input document, creating the hypermedia document via assigning information to the cards according to the logic structure file and displaying the cards together with the link order defined between them) (Tatsuji: paragraphs 0013, 0015-0017 and 0025-0032). However, although Tatsuji teaches reproducing image files and source files including pagewise scenario information and image information, Tatsuji fails to explicitly teach the image file is of a first predetermined format and the source file is of a second predetermined format, the first predetermined format being different from the second predetermined format and dragging and dropping the file icon on the execution icon to create the scenario file. Jackson teaches the creation of an index of cards, i.e. an index of files (Jackson: column 1, lines 38-50 and column 3, lines 26-36) similar to that of Tatsuji. In addition, Jackson further teaches dragging and dropping a file icon onto a target area to create a scenario file by converting files from one predetermined format to another predetermined format, the predetermined formats being different from one another (users can drag and drop an icon representing a bookfile to a targets area in order to index the combined documents; also, bookfiles can be converted

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from a binary "Maker" file format to a MIF format) (Jackson: column 1, lines 38-50, column 3, lines 25-36 and 61-67, and column 4, lines 58-67). It would have been obvious to one of ordinary skill in the art, having the teachings of Tatsuji and Jackson before him at the time the invention was made, to modify the creation of a scenario file of Tatsuji to include the conversion of a file from a source to a target format and creating an index of files upon a drag and drop operation of a file icon taught by Jackson. One would have been motivated to make such a combination in order to combine a plurality of documents of varying versions and formats and create an index from the combined documents for easy and convenient access of the documents.

Referring to claims 4, 20 and 21, Tatsuji teaches a scenario creating device, method and computer-readable storage medium comprising an input section including a pointing device (input part 11 comprising input devices such as a keyboard and mouse) (Tatsuji: paragraphs 0021-0022 and Figure 1); a display section (output monitor) (Tatsuji: paragraphs 0021-0022 and Figure 1); and a scenario creating section for creating the scenario file in accordance with operation of the input section (the editor creates the scenario, or link order of the cards of a presentation for display) (Tatsuji: paragraphs 0025-0032); wherein the scenario creating section provides a display of a scenario file creation area on the display section (scenario window 201 in Figure 8), the scenario file creation area including a file management area for displaying source files and a selected source file information area for displaying, in a sequence selected sequentially by a user, selected source file information representing information of a source file selected by the user in the file management area (displaying the source files, or cards of the presentation on the display, and the cards sequentially selected by the user and displayed in the

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scenario window 201) (Tatsuji: paragraphs 0053-0058 and Figure 8); and the scenario creating section creates the scenario file indicating a plurality of the selected source files in response to a content of the display in the selected source file information area (user's input of a scenario creation completion commands creates scenario information according to the order of the cards selected and arranged on the scenario window) (Tatsuji: paragraph 0058 and Figure 8); the selected source file information includes page indicating information indicating a page in the selected source file (indication of the chosen card order) (Tatsuji: paragraphs 0055-0057 and Figure 8). However, although Tatsuji teaches selecting a plurality of source files, i.e. selecting plurality of cards of the presentation, Tatsuji fails to explicitly teach the source files are of two or more formats. Jackson teaches the creation of an index of cards, i.e. an index of files (Jackson: column 1, lines 38-50 and column 3, lines 26-36) similar to that of Tatsuji. In addition, Jackson further teaches files of two or more formats (the documents and bookfiles maybe be of multiple versions and/or formats) (Jackson: column 1, lines 30-50 and column 3, lines 25-36). It would have been obvious to one of ordinary skill in the art, having the teachings of Tatsuji and Jackson before him at the time the invention was made, to modify the creation of a scenario file of Tatsuji to include the multiple source file formats taught by Jackson. One would have been motivated to make such a combination in order to combine a plurality of documents of varying versions and formats and create an index from the combined documents for easy and convenient access of the documents.

Referring to claim 6, Tatsuji, as modified, teach the selected source file information being displayed in the selected source file information area when a file icon for a source file displayed in the file management area is dragged and dropped into the

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selected source file information area by way of operation of the pointing device another (users can drag and drop an icon representing a bookfile to a targets area in order to index the combined documents) (Jackson: column 1, lines 38-50, column 3, lines 25-36 and 61-67, and column 4, lines 58-67).

Referring to claim 8, Tatsuji, as modified, teach a reduced image display area for displaying pagewise image information as a reduced pagewise image with regard to a source file of a predetermined format including pagewise scenario information and image information (Figure 8 of Tatsuji shows the display of the source file, i.e. the 12 cards making up the presentation and the display of reduced pagewise images, i.e. the display of each individual card representing part of the presentation), the source file being displayed in the file management area; and when a reduced pagewise image displayed in the reduced image display area is dragged and dropped (Jackson: column 1, lines 38-50, column 3, lines 25-36 and 61-67, and column 4, lines 58-67) into the selected source file information area by means of operation of the pointing device, the selected source file information including the page indicating information is displayed in the selected source file information area (upon user selection of a reduced pagewise image, i.e. a card of the presentation, with a mouse, the selected image, or card, is displayed in the selected source file information area, or scenarios window 201) (Tatsuji: paragraphs 0054-0058 and Figure 8).

Referring to claim 10, Tatsuji, as modified, teach a scenario supplying section for supplying the scenario file created by the scenario creating section to a scenario reproducing device but not supplying a source file, selected during creation of the scenario file, to the scenario reproducing device (outputting the hypermedia document

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created during document reproduction from the created scenario information for presentation on the display device) (Tatsuji: paragraphs 0017, 0021 and 0026-0028).

4. Claims 9 is rejected under 35 U.S.C. 103(a) as being unpatentable over Tatsuji JP 8-153104 and Jackson U.S. Patent 5,960,444, as applied to claim 4 above, and Meyn et al. U.S. Patent 5,829,623 (hereinafter "Meyn").

Referring to claim 9, although Tatsuji and Jackson teach creating a scenario file (Tatsuji: paragraph 0013), they fail to explicitly teach a network interface section for connection to a network, the scenario creating section selecting a source file stored in another external device connected to the network. Meyn teaches an interface for displaying and manipulating a scenario file (presentation) (Meyn: column 10, lines 49-67) similar to that of Tatsuji and Jackson. In addition, Meyn further teaches a network interface wherein the scenario creating section selects a source file stored in another external device connected to the network (the bus interface connects several external devices, such as a floppy disk drive 45 to the personal computer, allowing users to select a source file, i.e. PDF file, stored in the external floppy disk drive) (Meyn et al.: column 4, line 42 – column 5, line 65). It would have been obvious to one of ordinary skill in the art, having the teachings of Tatsuji, Jackson and Meyn before him at the time the invention was made, to modify the scenario file creating device of Tatsuji and Jackson to include the network connection of Meyn. One would have been motivated to make such a combination in order to give users the flexibility of accessing files stored anywhere and from anywhere, including accessing files stored in a remote computer or on the Internet.



*Response to Arguments*

5. Applicant's arguments with respect to claims 1-4, 6, 8-10 and 20-21 have been considered but are moot in view of the new ground(s) of rejection. However, in the interest of furthering prosecution, several of the applicant's arguments will be addressed.

6. With respect to claims 1-3, the applicant argues that Tatsuji does not disclose the source files and that since a plurality of cards of Tatsuji do not include scenario information, the plurality of cards of Tatsuji are not the "file icon" for the source file. The examiner respectfully disagrees. Tatsuji teaches the creation of a hypermedia document, i.e. a scenario file from a plurality of source files, i.e. a plurality of cards, as recited in paragraphs 0013-0015. For example, as shown by the scenario window 201 in Figure 8, a plurality of "file icons", i.e. cards 1-12, represent the source file made up of the 12 cards; Figure 8 also shows pagewise scenario information such as the link-order of the cards, as displayed on the right-hand side of scenario window 201. Therefore, the scenario file is created from file icons representing a source file and pagewise scenario, i.e. card-link, information.

7. Furthermore, with respect to claims 4, 20 and 21, the applicant argues that Tatsuji fails to disclose that the selected source file information includes page-indicating information indicating a page in the selected source file. The examiner respectfully disagrees. As shown in Figure 8 and further described in paragraphs 0055-0057, the user selected pages, i.e. cards of the source file are displayed in the window shown on the right-hand side of the scenario window. As can be seen from the right-hand side of the

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scenario window of Figure 8, the displayed user selected cards show information such as the card, or page number, indicating which card it represents, as well as linking information to the next card; therefore, Tatsuji teaches page, or card indicating information such as the card number indicating the selected card of the source file.

### *Conclusion*

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ting Zhou whose telephone number is (571) 272-4058. The examiner can normally be reached on Monday - Friday 7:00 am - 4:30 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Cabeca can be reached at (571) 272-4048. The fax phone number for the organization where this application or proceeding is assigned is (571) 273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

TZ



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PRIMARY EXAMINER